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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN BARRITZ and ROBERT BARRITZ

Appeal 2008-006310
Application 10/034,858¹
Technology Center 2100

Decided: August 12, 2009

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and CAROLYN
D. THOMAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed December 27, 2001. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/258,740, filed 12/29/2000. The real party in interest is Treetop Ventures, LLC.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 7, 14 to 15, 17, 19 to 25, 27, 29 to 33 and 35 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 16, 18, 26 and 28 are allowed, per the Advisory Action mailed 12/12/06. Claims 8 and 34 are objected to in that Advisory Action mailed 12/12/06 (continuation page) but are also checked as being rejected on the front page of the Action. The Examiner has not made a formal rejection of claims 8 and 34 nor dependent claims 9 through 13. We thus do not have a rejection on those claims that can be properly appealed to this tribunal, and thus we cannot rule on those claims. Concerning the other claims, we affirm the Examiner's rejections of claims 1 to 7, 14 to 15, 17, 19 to 25, 27, 29 to 33 and 35.

Appellants' invention relates to a system and method for refining a search structure when searching for items or information on Internet databases and the like. In the words of the Appellants:

Thus, it is the object of the invention, called the Cooperative Categorization System (CCS), to provide a means whereby the creation of a detailed CS takes the form of a cooperative activity in which the users of the CS propose and supply additional categories and attributes to extend the CS to meet their needs, with the CCS system further shaping, refining and adapting the organization of information based on the observed behavior of the listers and searchers of the system.

In the preferred embodiment, the CCS, while primarily hierarchical in the manner of an NHCS, also employs attributes in the manner of an ACS.

It is a further object of the invention to provide

a system and method which automatically achieves clustering of the results of search engines by observing the results referenced by the user, without requiring that the user actively specify additional or modified search terms.

The foregoing and other objects of the invention are realized by a system and process which uses the aforementioned cooperative categorization system of the present invention and also or alternatively uses a technique known as automatic clustering, which minimizes or eliminates the need for an SE user to successively refine his/her search terms in a manual fashion, in order to improve the relevance of results.

(Spec. 14, l. 20 to 15, l. 12).

Claim 1 is exemplary:

1. An interactive system of enhancing an ability for data to be searched, the interactive system comprising:

a categorization system that associates search terms defining categories or attributes with items to be found;

a communication system that communicates with the categorization system and with a store of information from which information is to be selected based on the search terms; and

a cooperative facility associated with the categorization system that users, including listers and searchers, use to interactively and at least partially automatically, modify or supplement the search terms initially assigned to the items to be found by the categorization system, wherein the categorization system, communication system and cooperative facility are structured to store the modified or supplemented search terms.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Chen	6,728,752	Apr. 27, 2004 (filed Oct. 19, 1999)
Suchter	6,675,161	Jan. 6, 2004 (filed May 4, 1999)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 7, 14 to 15, 17, 19 to 25, 27, 30 and 32 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Suchter.

R2: Claims 29, 31, 33 and 35 stand rejected under 35 U.S.C. 103(a) for being obvious over Suchter in view of Chen.

Groups of Claims:

Claims will be discussed in the order of the rejections.

See 37 CFR § 41.37 (c) (vii). *See also* In re McDaniel, 293 F.3d 1379, 1383 (Fed. Cir. 2002).

Appellants contend that the claimed subject matter is not anticipated by Suchter or rendered obvious by Suchter in combination with Chen for failure of the cited references to teach certain limitations of the claims. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). The issue turns on whether Suchter shows users, as defined by the claims, using the system to interactively modify search terms assigned to items to be found by the categorization system, as expressed in the claims.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system that interactively and partially automatically modifies categories and search attributes assigned to data to help users more effectively search the Internet. (Spec 14, l. 25). Users search by word searching or categorization system (CS) (Spec 2, l. 19). There are three types of users who typically use the CSs: hosts of the system, such as the owners of eBay; listers who are selling items using the system; and searchers who are accessing information or finding items. (Spec. 11, ll. 11 to 29).
2. Suchter teaches a method and apparatus for managing changes to a directory of electronic documents that are to be searched on the Internet. (Col. 1, l. 14; col. 4, l. 20). The system has a Review Category sub-function that allows users to “display, re-order, and modify attributes of electronic documents that are classified in a particular category.” (Col. 10, ll. 65 to 67). An administrative user can set the permissions granted to other users to determine which ones may modify the categories by which the documents are organized. (Col. 9, l. 28).

3. The Chen patent teaches a method and system for document browsing on the Internet in which a user's prior searches are used to iteratively narrow a search of documents. (Col. 4, l. 21 to 25). Documents may be recommended based on the prior searches of the user. (Col. 6, l. 32).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

However, although elements must be arranged as required by the claim, "this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required" *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n.11 (Fed.Cir.1986)).

"[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

The analysis begins with an interpretation of the claims: “Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

The “intended use” of a machine is not germane to the issue of patentability of the machine itself. *In re Casey*, 370 F.2d 576, 580, (CCPA 1967). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. *See generally Kropa v. Robie*, 187 F.2d 150, 155-59 (CCPA 1951) and the authority cited therein, and cases compiled in 3 Donald S. Chisum, *Chisum on Patents* § 8.06[1][d] (2009). Such statements often, although not necessarily, appear in the claims preamble. *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987).

“Claim 1 is an apparatus claim. Thus, structural and functional limitations of the system are at issue. . . . While a user interacts with the system, the user is not part of the system itself. The court’s construction, therefore, must focus on system limitations, and must be based on the standpoint of the system.” *Blackboard, Inc. v. Desire2Learn*, 2007 WL 2255227 (*E.D. Tex* 2007.)

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. §§ 102 and 103. The prima facie case is presented on pages

3 to 9 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 7, 14 to 15, 17, 19 to 25, 27 30 and 32
under 35 U.S.C. § 102(e) [R1]*

Appellants contend first that Examiner erred in rejecting the noted claims over Suchter as the users who would be called “listers” and “searchers” in Suchter cannot “interactively modify or supplement search terms that are initially assigned to items to be found by a categorization system.” (Brief 8, middle). Instead in Suchter, it is the “owners” who have the power to modify the search terms.

Claims are subject to interpretation for examination. See *Medichem*, 353 F.3d at 933. Claims are properly read in light of the specification but without the limitations of the specification being actually imported into the claims. See *Phillips v. AWH Corp.* 415 F3d 1303, 1316 (Fed. Cir. 2005). As the Appellants indicate, the specification does distinguish between three types of users of the system. (See FF1 above.)

In effect, by this argument, Appellants argue that a system claim should be granted over the prior art based on the job description of the person using the system. We find no basis for that in the patent law: a machine or manufacture claim is defined by the structural or functional limitations of the claim; whether a screwdriver is to be wielded by a mechanic or an amateur makes no difference in the claim for the screwdriver itself. (See *Blackboard, Inc. v. Desire2Learn*, cited above.)

However, in further support of the rejection, the Examiner points to the teaching in Suchter where “an administrative user can set permissions of

other users by designating which users can modify judgements.” [sic] (Suchter Col. 9, ll. 27 to 29; Answer 9, bottom). We thus find a basis for the literal anticipation of the claim limitation “users, including listers and searchers, use.” (Claims 1, l. 8).

Appellants next contend that Suchter does not teach the use of search terms but instead a directory structure that is an index of documents. (Brief 10, middle). The Examiner points out that the directory structure, for example in Figure 3A, organizes the documents by categories and attributes that are searchable, such as the terms listed under “arts”. See Answer, page 11. For the reasons therein expressed, we do not find error with this rejection.

*Arguments with respect to the rejection
of claims 29, 31, 33 and 35
under 35 U.S.C. § 103 [R2]*

Appellants contend that Chen fails to supply the features lacking in Suchter, particularly the automatic clustering tool that interactively creates and stores categorization criteria.

Chen was cited by the Examiner for its teaching of adapting a search based on the user’s prior browsing behavior. (Col 17, l. 66 to col. 18, l. 36). This teaching is said to render obvious the claimed monitoring which particular result-items the user has historically chosen to visit. (Answer 7, bottom). We agree, and find the rejection under 35 U.S.C. § 103 sufficiently supported.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 7, 14 to 15, 17, 19 to 25, 27, 29 to 33 and 35 under R1 and R2 as expressed above.

DECISION

R1: The Examiner's rejection of claims 1 to 7, 14 to 15, 17, 19 to 25, 27 30 and 32 under 35 U.S.C. § 102(e) for being anticipated by Suchter is affirmed.

R2: The Examiner's rejection of claims 29, 31, 33 and 35 under 35 U.S.C. 103(a) for being obvious over Suchter in view of Chen is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PEB

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